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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,184	07/20/2001	Joseph Porat	205,073	1503

7590 06/04/2003
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EXAMINER

STINSON, FRANKIE L

ART UNIT	PAPER NUMBER
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1746

2

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/910,184

Applicant(s)

PORAT, JOSEPH

Examiner

FRANKIE L. STINSON

Art Unit

1746

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 31-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 24-30 is/are rejected.
- 7) ☒ Claim(s) 19-23 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1746

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I: Claims 1-30, drawn to an automated power-driven pool cleaning apparatus, classified in Class 134, subclass .

Group II: Claims 31-33, drawn to method for controlling movement of cleaning apparatus, classified in Class 134, subclass 18.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as apparatus and process for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (M.P.E.P. § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as transporting objects from one place to another or sensing an object in a pipe or room.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, have acquired a separate status in the art because of their recognized divergent subject matter, the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. Thomas E. Spath on January 10, 2003 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-

Art Unit: 1746

30. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 31-33 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Art Unit: 1746

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-5, 8, 9, 11, 18 and 24-28 rejected under 35 U.S.C. 102(e) as being clearly anticipated by Erlich et al.

Note Erlich, as at col. 21, lines 45-67 thru col. 22, lines 1-64, where Erlich discloses a pool cleaner comprising an automated power-driven pool cleaning apparatus comprising a programmable control device for detecting movement, a motion translating member (i.e. the non-driven supporting wheel and/or auxiliary wheel, col. 22 line 25), a signal transmitter/receiver (incorporated in the IC --Integrated Circuit--device), wherein the control device is programmed to change the direction of movement of the apparatus when the out put of the sensor indicates that the apparatus has not moved in a prescribed period of time (the predetermined delay period, col. 22 line 52-53). Also note the light device as discussed at col. 22, lines 58-64.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 6, 7, 29 and 30 rejected under 35 U.S.C. 103(a) as being unpatentable over Erlich et al.

Claim 6 defines over Erlich only in the recitation of the traction surface being made of a polymeric material. Nonetheless, no patentable distinction is deemed to exist between the traction surface as inherently taught by Erlich, and the polymeric material as claimed. This is also applicable to the subject matter of claims 7, 29 and 30, namely, with regard to claim 7, the motion translating member (mtm) being spherical (Erlich teaches the "mtm" being a wheel); with regard to claim 29, the light source and photocell as claimed (Erlich teaches an IR light source and light sensor) and with regard to claim 30, the prescribed time period of 5 seconds as claimed (Erlich teaches a programmable time period of 1.5 to 3 minutes).

10. Claims 10, 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erlich et al. in view of Minami et al.

Claim 10 defines over Erlich only in the recitation of the transmitter being mounted on the periphery of the wheel. Minami is cited disclosing in an automated power-driven pool cleaning apparatus, a wheel (42, see figs. 2 and 13 for example) having a transmitter (44) located at its periphery. It therefore would have been obvious to one having ordinary skill in the art to modify the device of Erlich, to employ a wheel and transmitter as taught by Minami, for the purpose of ensuring proper indication of the movement of the power-driven apparatus. Re claim 12, Minami discloses the sensor being mounted on the apparatus and being located both proximate and distanced the transmitter (as the wheel rotates). Re claim 13, Minami discloses the magnet (as at 44

and in Erlich as at col. 22, line 22). Re claim 14, Erlich discloses the reed switch as at col. 22, line 27. Re claims 15 and 16, Erlich discloses the permanent magnet proximate the reed switch as claimed. Re claim 17, Minami discloses that a plurality of magnets may be positioned around the rim of the wheel.

11. Claims 19-23 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In Wulc, Henricksen, Nystrom, Babcock, Myers, Strausak, Pansini, Davidsson et al., Erlich, and Japan'251, note the powered-driven pool cleaning devices.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANKIE L. STINSON whose telephone number is (703) 308-0661. The examiner can normally be reached during the first week of the pay-period M-F from 5:30 a.m. to 3:00 p.m. and during the second week of the pay-period from Tu-Th second from 5:30 a.m. to 3:00 p.m. and on Fri. from 5:30 a.m. to 2:00 p.m. Alternating Mondays off.

The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7719.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Application/Control Number: 09/910,184

Page 7

Art Unit: 1746

Any inquiry for missing parts of this Office Action (copies of references, pages, forms etc.), contact Office Manager Ms. Sandra Sewell (703) 308-0661.

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FRANKIE L. STINSON
Primary Examiner
Art Unit 1746